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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/782,765 | 02/13/2001 | Kelli Hodge Kennedy | 10005680-1 | 9673 |

7590

04/04/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER

BACKER, FIRMIN

ART UNIT PAPER NUMBER

3621

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,765

Applicant(s)

KENNEDY ET AL.

Examiner

FIRMIN BACKER

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1,3-7,9,10,12-17,19,21,23-27,29 and 30.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9,10,12-17,19,21,23-27,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9,10,12-17,19,21,23-27,29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received..
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Appeal Brief

1. This is in response to an Appeal Brief file on February 5th, 2006. Prosecution is hereby reopened and a non final action is issued.
2. Applicant's argument for the objection to the specification and the rejection based on 112 2nd, is persuasive and, therefore, is withdrawn. However, upon further consideration of the amendment filed May 4th, 2005, Examiner still maintained that new matter was added to the claims and are therefore rejected under 112 1st. Furthermore, this action is considered to be final.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 3-7, 9, 10, 12-17, 19, 21, 23-27, 29, and 30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 1, 9, 10, 19, 26 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant disclose in claims 1, 9, 10, 19, 26 and 27 “**presenting the list of distribution options for the document to the document provider.**” Applicant teaches throughout the disclosure an the inventive concept of “**compiling a list of distribution options for the document based on the document distribution services of the document distribution providers, and presenting the list of distribution options for the document to the user.**” (*see abstract, paragraphs 0005 and several other places in the disclosure*). To the best of the Examiner expertise and to one of ordinary skill in the, these two concept are considered to be different. Therefore, the concept of “presenting the list of distribution options for the document to the document provider” is considered to be new matter and not disclose in the specification as claimed by the Applicant.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 1, 3-7, 9, 10, 12-17, 19, 21, 23-27, 29, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Straub et al (U. S Patent No 6,216,141).

8. As per claims 1, 9, 10, 19, Straub et al teach a method of distributing a document of a user, the document including at least one of textural and graphical information, the method comprising registering document distribution services of a plurality of document distribution providers with a document distribution system controller, the document distribution services including at least one of print services, electronic mail services, and publishing services; receiving a distribution request for the document from the user at the document distribution system controller, compiling a list of distribution options for the document with the document distribution system controller based on the document distribution services of the document A distribution providers, and presenting the list of distribution options for the document to the document provider (*see abstract, figs 1, 3, 4, 7, 11, 12 and their accompanied text, and column 2 lines 29-3 lines 67, 9 lines 9-46*).

9. As per claims 3-7, 11-17, 21 and 23-27 and 30, they disclose the same inventive concept as claims 1, 9, 10 and 19. Therefore, they are rejected under the same rationale.

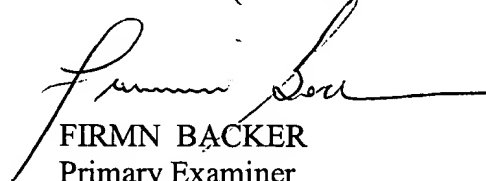
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMN BACKER whose telephone number is 571-272-6703.

The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


FIRMN BACKER
Primary Examiner
Art Unit 3621

March 23, 2006